In support of the present Restriction Requirement, the Office Action alleges that the subject matter defined by the claims represent three separate and distinct inventions. Furthermore, the Office Action alleges that each of the groups identified as I-III require separate and distinct searches in the literature and on the computer.

Applicants submit that the present Restriction Requirement is confusing since it does not encompass all of the claimed subject matter. More specifically, as presently claimed, the present invention encompasses compounds which do not contain a phosphorus (subject matter of Groups I and III) or a sulfur (subject matter of Group III). Applicants' attorney contacted Examiner Criares to clarify the confusion.

Applicants wish to thank Examiner Criares for the courtesy extended to its attorney during said interview.

Examiner Criares indicated in said interview that Group III contains all groups, except those containing phosphorus. On the basis of that representation in order to be fully responsive to the requirement for restriction, applicants provisionally elect to prosecute the subject matter of Group III. Nevertheless, applicants reserve the right to file a Divisional application directed to the remaining non-elected subject matter present in the application.

Pursuant to 37 C.F.R. §§1.111 and 1.143, applicants hereby traverse the requirement for restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single application." (emphasis added). Similarly, 37 C.F.R. §1.141(a)

permits restriction conditioned upon the finding that independent and distinct inventions are found within a single application. Even assuming, pro arguendo, that the Office Action was correct with respect to distinctiveness there is absolutely no indication that Groups I-III are also independent.

In fact, applicants submit that the groups are not independent. For two or more inventions to be considered independent, there must be no disclosed relationships between the inventions in question, i.e., they are unconnected in design, operation or effect. M.P.E.P. §802.01. The subject matter in Groups I-III are directed to compounds useful for treating convulsions. Therefore, it is clearly evident that these groups of claims have a disclosed relationship and are therefore not independent. Id. Therefore, in light of the foregoing statutory and regulatory criteria, the present Restriction Requirement cannot be maintained since the inventions are not independent from each other.

Furthermore, the Restriction Requirement is not in compliance with the M.P.E.P. It is well established that the Office Action must provide a rationale on the record to support a Restriction Requirement. More specifically, M.P.E.P. §808 states:

> The requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (2) the reasons for insisting upon restriction therebetween.... (emphasis in original).

In the present case, the Office Action has failed to show or provide adequate reasoning to support the Restriction Requirement. The Office Action concludes that each group represents a separate and distinct invention, without providing any rationale in support thereof. Furthermore, the Office Action cites no reference or teaching that supports the allegation in

the Office Action that the claims in the various groupings are patentably distinct. The Office Action merely concludes, without providing any reasoning whatsoever, that the various groups are regarded as distinct and independent. Consequently, the Restriction Requirement is not in compliance with M.P.E.P. §808, and withdrawal thereof is respectfully requested.

It should also be observed that the requirement for restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142; it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D.Va. 1966), aff'd, 374 F.2d 511, 153 USPQ 91 (4th Cir. 1967). Therefore, to promote the interest of both the public and the applicants, the Restriction Requirement should not be imposed without a specific analysis which supports the conclusions that two or more independent and distinct inventions are claimed in one application.

In addition, the courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The CCPA has observed:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

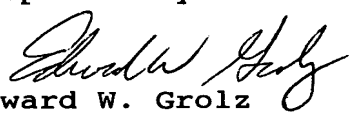
In re Kuehl, 456 F.2d 658, 666, 177 USPQ 250, 256 (CCPA 1973).

Furthermore, applicants respectfully request that in view of increased Official Fees and the potential limitations of

applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may be come prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,



Edward W. Grolz
Attorney for Applicants
Reg. No. 33,705

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

MJC:ds